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MAILED

JUN 03 2010

OFFICE OF PETITIONS

In re Patent No. 7,186,495 :
Maeda et al. : DECISION ON REQUEST
Issue Date: March 6, 2007 : FOR RECONSIDERATION OF
Application No. 09/750,116 : PATENT TERM ADJUSTMENT
Filed: December 29, 2000 : AND NOTICE OF INTENT TO
Attorney Docket No. NEC99P156-MS : ISSUE CERTIFICATE OF
: CORRECTION

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN THE PATENT UNDER 37 C.F.R. § 1.705(d)" filed on May 4, 2007. Patentees request that the Patent Term Adjustment for the above-identified patent be increased by 912 days from 499 days to 1411 days. For the reasons stated below, this petition is treated as a petition requesting the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand fifty-six (1056) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand fifty-six (1056) days is **GRANTED to the extent indicated herein.**

With regards to the "B" delay period, the over three year period begins on December 30, 2003, the day after the date three years after the date the application was filed and ends on March 6, 2007, the date the patent issued. However, this period does not include the number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve

the application in the interference and ending on the date that the interference was terminated. 37 CFR 1.703(b)(2)(i). On April 1, 2005, an interference was declared. On September 15, 2005, 168 days after the interference was declared, it was terminated. Therefore, the 168 day period must be excluded from the "B" delay period. Considering the 237 day overlapping period, from the period beginning on the day after the date that is four months after the date after the Board of Appeals and Interferences Decision was mailed and ending on the date of the mailing of the Notice of Allowance and the 24 day overlapping period beginning on the day after the date that is four months after the date the issue fee was paid and ending on the date the patent issued, the non-overlapping "B" delay period is 734 (1163 - 168 excluded - 237 - 24) days.

Further, as stated above, it is noted that the period from four months after the date of mailing of the decision of Board of Patent Appeals and Interferences ("Board Decision") mailed on July 15, 2005, to the mailing of the notice of allowance mailed on July 10, 2006, is incorrectly stated. While the decision on patent term adjustment mailed on January 23, 2007, states the period of Office delay as "273 days" a review of the record reveals that the actual period of delay is 237 days. Accordingly, the period of Office delay of 273 days will be removed, and a period of Office delay 237 days will be entered.

Patentees assert that the 105 day time period accorded pursuant to 37 CFR 1.702(c) for the number of days, if any, in the period beginning on the date an interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application, is incorrect. Specifically, patentees assert that the date of termination of the interference is September 15, 2005, the date which is two (2) months after the mailing of the Board Decision, and the end of the two (2) month period during which an appeal of the decision can be taken or other review can be had.

Patentees are correct. The interference was terminated on September 15, 2005, not July 15, 2005. Accordingly, the period under 37 CFR 1.703(c) is 168 days, not 105 days. The 105 day period will be removed and a 168 day period will be entered.

Patentees additionally argue that a 1075 period starting four months from the date of filing a reply on March 13, 2003, to the

mailing of the notice of allowance on July 10, 2006, should be entered. Specifically, petitioners state that the suspension of action mailed on June 20, 2003, is not an action under 35 USC 132 pursuant to 37 CFR 1.703(a)(3) in that it does not constitute a rejection, objection, or requirement, and did not set a time for prosecuting the application under 35 USC 133.

Patentees' argument has been considered, but is not persuasive. The letter of suspension mailed on June 20, 2003, is considered an action under 35 USC 132.

In this regard, 35 USC 132(a) states, in pertinent part:

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined.

Patentees' argument is not well taken because the Office letter mailed on June 20, 2003 was a letter from the examiner stating that all claims were allowable, and stated that prosecution was suspended for six months. Accordingly, the requirements of 35 USC 132 were met, and the period for Office delay pursuant to 37 CFR 1.703(a) for a response to the reply filed on March 31, 2003, was met with the mailing of the Office letter mailed on June 20, 2003.

Further to this point, with regard to any delay between the mailing on June 20, 2003, of the Office communication suspending prosecution, the mailing on April 1, 2005, of the declaration of interference, and, ultimately, the mailing on July 10, 2006, of the notice of allowance, the Office has no authority to grant an extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

Pursuant to 35 U.S.C. 154(b)(1)(A)(ii), applicants are only entitled to day-to-day restoration of term lost as a result of delay created by the failure of the Office to respond to a reply

under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken. In this regard, the Office did respond within four (4) months to petitioners' amendment filed on March 31, 2003, by mailing the Office communication initiating suspension of action mailed on June 20, 2003. That a declaration of interference was later made, and that a notice of allowance was ultimately mailed, on July 10, 2006, does not alter the fact that the Office did respond to the reply within 4 months after the date on which the reply was filed.

The patent term adjustment will be updated to one thousand fifty-six (1056) days (421 (160 + 237 + 24) + 734 + 168 - 267 applicant delay).

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand fifty-six (1056) days**.

Telephone inquiries specific to this matter should be directed to Douglas I. Wood, Senior Petitions Attorney, at (571) 272-3231.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,186,495 B2

DATED : March 6, 2007

DRAFT

INVENTOR(S) : Maeda et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 499 days.

Delete the phrase "by 499 days" and insert -- by 1056 days--